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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 07/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/400,649

Applicant(s)

SZABO, ANDREW J.

Examiner

Sam Rimell

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2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-33 and 35-74 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 29-33, 35-74 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:


SAM RIMELL
PRIMARY EXAMINER

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

~~Claim 32:~~ The phrase "top assist the user" is confusing.

~~Claim 74:~~ Claim 74 depends upon claim 32.

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ANTECEDENT
PROBLEM

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51, 60 and 67-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 51: The original disclosure contains no mention of a "risk model". Although the disclosure does discuss the element of risk, there is no mention of a "risk model".

(TWICE MENTIONED
ONE ELEMENT)

Claim 60: The original disclosure contains no mention of a "likelihood of adoption of a record by a user".

Claim 67: The original disclosure contains no mention of a "likelihood of user adoption".

Claims 68-73: Claims 68-73 depend from claim 67.

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Claims 51, 60 and 67-73 are considered to contain new matter and will not be further examined on the merits.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-33, 35-50, 52-59, 61-66 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayaud (U.S. Patent 5,845,255).

Claim 29: FIG. 7 of Mayaud discloses a user interface which receives input from a user in the form of a medical condition to evaluate records (medications) for prescription to a patient. In the case of FIG. 7, the user input is the condition "PUD/Gastritis". A subset of records (suggested medications) are then created based upon the classification of information (formulary/non-formulary drugs) and the user input ("PUD/Gastritis"). Col. 19, lines 28-30 calls for further user input on user allergies, which are a statistical risk to the patient. Col. 39, lines 63-67 state that the statistical risk of potential allergies or drug interactions are evaluated, based on all the input. Col. 39, lines 44- 54 state that costs associated with particular drugs are also considered. The final drugs selection made by the physician is thus optimized to take into account risks of allergy and drug interaction, as well as economic cost.

Claim 30: The user input ("PUD/Gastritis") is health information.

Claim 31: Col. 19, lines 28-30 call for the input of patient allergies, which reads as an input of data pertaining to risk tolerance.

Claim 32: FIG. 7 is a user interface.

Claim 33: The economic parameters which are considered (col. 39, lines 44-54) pertain to cost.

Claim 35: The user input ("PUD/Gastritis") is a semantic expression.

Claim 36: In FIG. 7, the user can input a preference, such as a preference for formulary or non-formulary medications.

Claim 37: The user feedback is a selection of a drug for a patient. If the user receives warnings about that drug (col. 40, lines 1-19), the drug selection can be cancelled and another drug selection made.

Claim 38: Col. 39, lines 44-54 outline a plurality of different optimization procedures which can be followed.

Claim 39: Col. 9, lines 44-45 call for the creation of an electronic prescription which is transmitted electronically to a pharmacy. This inherently leads to the transaction of a sale of a medication at a pharmacy.

Claim 40: The transmission of the electronic prescription is a transmission between a server (206) and a client computer at a pharmacy.

Claim 41: The system of Mayaud utilizes the Internet (col. 48, line 2).

Claim 42: The system of Mayaud is implemented by a network of a computer systems each containing programmed instructions for controlling the respective computers.

Claim 43: FIG. 7 is a graphic user interface.

Claim 44: See claim 29. The user relevance parameter is the input of ("PUD/Gastritis") by the user in FIG. 7.

Claim 45: See remarks for claim 30.

Claim 46: The facility (206) functions as a search engine for searching databases (210, 212).

Claim 47: See remarks for claim 41.

Claim 48: See remarks for claim 33.

Claim 49: Col. 40, lines 1-10 discuss the presentation of drugs, as well as choices of alternative drugs that can be presented to the user. These choices are presented based upon the user input of risks (allergies/interactions) and economic parameters (cost).

Claim 50: The input of a disease by a user, such as "PUD/Gastritis" pertains a population grouping, since a population of patients can have this disease.

Claim 52: See remarks for claim 37.

Claim 53: See remarks for claim 38.

Claim 54: See remarks for claim 39.

Claim 55: See remarks for claim 40.

Claim 56: See remarks for claim 41.

Claim 57: See remarks for claim 42.

Claim 58: See remarks for claim 43.

Claim 59: See remarks for claim 29. The "specification" is the indication of disease "PUD/Gastritis" by the user in FIG. 7.

Claim 61: See remarks for claim 38.

Claim 62: Col. 19, line 30 calls for the input of a relevance profile (allergic reaction information).

Claim 63: See remarks for claim 39.

Claim 64: See remarks for claim 41.

Claim 65: See remarks for claim 42.

Claim 66: See remarks for claim 43.

Claim 74: Col. 39, line 50 illustrates that the economic parameters are dictated by an external third party (benefit management company).

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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